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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,884	09/27/2000	Juan A.Morales Tirado	D/A0571	7382

7590

08/26/2002

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EXAMINER

SCHLAK, DANIEL K

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/670,884	Applicant(s) TIRADO ET AL.	
	Examiner Daniel K Schlak	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18,22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 16 is objected to because of the following informalities:

Lines 15-18 of this claim are identical to lines 10-12 of the same claim. Please remove the repetitious recitations.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with vague and indefinite language. The majority of such indefinite language arises from lacks of antecedent basis.

The following recitations are without antecedent basis:

Claim 1, line 2: "the center of the disk"

Claim 2, line 1: "the thickness"

Claim 2, line 2: "the periphery"

Claim 3, line 3: "the thickness"

Claim 4, line 1: "the diameter"

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Claim 5, line 1: "the diameter"

Claim 6, line 1: "the diameter"

Claim 7, line 1: "the diameter"

Claim 10, line 5: "the peripheral edge"

Claim 10, line 7: "the center"

Claim 10, line 8: "the particle outlet opening"

Claim 10, line 10: "the diameter"

Claim 15, line 2: "the peripheral edges of the wheel"

Claim 10, line 8: "the peripheral edges"

Claim 16, line 10: "the center"

Claim 16, line 11: "the particle outlet opening"

Claim 16, line 14: "the diameter"

Claim 22, line 2: "the center"

Claim 22, line 3: "the particle outlet"

Claim 23, line 2: "the diameter"

Claim 23, line 1: "the adjustment"

For the above recitations and their lacking antecedent basis, applicant is reminded that the disk disclosed in the instant application has several peripheral edges, several thicknesses, and several diameters. Further, it has never been asserted that the disk has a center, where the center is, etc. Please provide antecedent basis for these recitations or remove them from the claims.

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Please revise the claims to remove all instances of indefiniteness. The Examiner has attempted to locate them all, but has not the time to proof-read and edit pages of claims. Failure to remove all recitations lacking antecedent basis will result in a final rejection.

Further instances of indefiniteness are as follows:

Claim 2, line 2, recites "the disk is thicker". Thicker than what? Thicker than a piece of paper?

Claim 2, line 2, recites "and thinner..." Thinner than what?

Claim 3, line 2, recites "circular opening which has a thickness..." How can an opening, which is defined as a void, have a thickness?

Claim 4, line 2, recites "opening is fixed..." Fixed to what? Fixed in time? Fixed to an elephant? Clearly some further delineation of this relationship is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10, and 16 recite "adapted to concentrically attach the disk to a (the) particle outlet opening of a classifier wheel."

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The functional recitation that "the adjustment of the diameter of the circular opening is accomplished with a centrifugal value" has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 U.S.C. 112, 6th Paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Given the above explanation of the "adapted to" recitation and functional recitations, and the indefiniteness of the claims as described in the rejections under 35 U.S.C. 112, 2nd Paragraph, the following rejections should need no explanation.

Claims 1-9, 22, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 4,841,518.

See figure 8, element (J).

Claims 1-9, 22, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,123,711.

See figure 1, element (16).

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Claims 1-9, 22, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,774,445.

See figure 1, item 7.

Claims 1-9, 22, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 4,703,636.

See figure 2, element (6).

Claims 1-9, 22, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 3,879,980.

See figures 4, 5, and 6, element (12).

Claims 1-8, 22, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US d30995.

See figure 3.

Claims 1-9, 22, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,522,706.

See figure 1, element (8).

Claims 1-9, 22, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,633,856.

See figure 3, element (3).

Claims 1-7, 22, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US d32,793.

As is clear from the above rejections, the claims are entirely too broad. The search which produced these references took approximately 1 hour, and was performed by Examiner Schlak who has no experience whatsoever searching for disks. In the event that Applicant wishes to pursue claims directed to the disk, a full search will be performed, and counsel will be sought by said Examiner from Examiners who know the "disk" art much better. Again, the "adapted to" language hardly distinguishes the "disk" of the instant application from any other "disk" disclosed in any disclosure anywhere.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

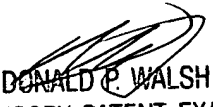
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dks

August 21, 2002



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